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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,611	12/17/2001	Yuki Sasaki	111482	5891

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EXAMINER

MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,611	SASAKI ET AL.	
	Examiner	Art Unit	
	Gregory W. Mitchell	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office Action is in response to the Remarks, Amendments and Declaration filed on March 16, 2005. Claim 1 has been amended. Claims 1-22 are pending. Claims 18-22 have been withdrawn from consideration as being directed to a non-elected invention. Claims 1-17 are examined herein.

Claims 1-17 remain rejected over the art of record. The claims are re-written below for Applicants convenience and to address the narrower claim language of "consisting essentially of" added by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6-10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiyama et al. (USPN 6080519).

Ishiyama et al. discloses a binder resin for use in a toner, said binder resin having a volume average particle diameter in the range of 2 to 9 microns, a diameter distribution coefficient GSDv of 1.30 or less, and a number average particle diameter distribution coefficient GSDp of 0.95 or more (col. 3, line 11-col. 4, line 7). The particles are taught to have a shape factor SF1 in a range of from 110 to 140 (col. 4, lines 8-12). A resin with a mean particle diameter of 160 nm, a glass transition point of 58° C, and a

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weight average molecular weight of 35,000 is specifically disclosed (col. 14, lines 20-23).

It is Examiner's position that Applicant's recitations of specific surfaceness index values, volumetric ratios, compaction ratios, volatility, surface tension, and conductivity are properties of the resin particles. Accordingly, because Ishiyama et al. discloses the same resin particles, it is Examiner's position, that the particles of Ishiyama et al. will, inherently, possess the properties claimed in claims 2, 4, 8-10 and 12-14. A chemical composition and its properties are inseparable. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* of anticipation has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

It is noted that there is no teaching of any water content in the resin particles of Ishiyama et al. and that 0% is less than 3%.

It is also noted that no weight is given to the intended use of "for a dermatological composition" recited in claim 1. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. MPEP 2112.01.

Finally, it is pointed out that for purposes of searching for and applying prior art under 35 USC 102, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation "consisting essentially of", Applicant ^{has} ~~as~~ the burden of showing that the introduction of additional steps or components would materially change the characteristics of Applicant's invention. See MPEP 2111.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 11 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiyama et al. (USPN 6080519), as applied to claims 1, 2, 4, 6-10 and 12-14 above, and further in view of Hagi et al. (USPN 5976750).

Ishiyama et al. applies as disclosed above. Ishiyama et al. further teaches that that the acid value of the resin particles should be from 10 to 50 mg-KOH (col. 4, lines 47-51). Ishiyama et al. does not teach the specific GSDp, specific molecular weight, specific acid value range, or additional fine particles adhered to the resin particles.

Hagi et al. teaches toner particles comprising a colorant and a binder resin having a volume-mean particle size of 3 to 7 microns and an SF1 of 100 to 130 (col. 3,

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lines 9-12). It is taught that the resin particles may have inorganic fine particles of a size of 5 to 60 nm externally added in order to increase fluidity of the toner (col. 4, line 33-col. 6, line 40). The number-mean molecular weight of the resin particles is taught to be between 3000 and 6000 and the glass transition temperature is taught to be between 50 and 70° C (col. 6, lines 51-67). It is pointed out that size of the fine particles taught by Hagi et al. are less than half the size of the resin particles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to adhere other small particles to the resin particles of Ishiyama et al. because (1) both Ishiyama et al. and Hagi et al. are drawn to resin particles for use in a toner; (2) both Ishiyama et al. and Hagi et al. are drawn to resin particles of the same size, possessing similar glass transition temperatures, and possessing similar shape factor SF1 values; and (3) Hagi et al. teaches that fine particles may be added to the resin particles taught therein. One would have been motivated to add the second smaller particles to the resin particles because, as taught by Hagi et al., they serve to improve the fluidity of the toner.

Furthermore, it would have been obvious to one of ordinary skill in the art to use a resin particle of Ishiyama et al. comprising a number-average molecular weight of between 3000 and 6000, as taught by Hagi et al., because of analogous nature of the two references, as described above. A resin powder with a particle size distribution GSDp of 1.5 or less and an acid value of between 1.0 and 20 mg/KOH/g would have also been obvious to one of ordinary skill in the art because the range of each overlaps with the ranges taught by Ishiyama et al.

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It is Examiner's position that Applicant's recitations of specific adhesive strength ratio of the fine particles to the resin particles are properties of said fine particles and resin particles. Accordingly, because Ishiyama et al. in view of Hagi et al. teaches the same resin particles, it is Examiner's position that the particles rendered obvious by Ishiyama et al. and Hagi et al. will possess the properties claimed in claim 17. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* of obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Response to Arguments

Applicant's arguments regarding the 35 USC 102 and 103 rejections set forth above are not persuasive.

Applicant argues, "In contrast to the resin powder of claim 1, Ishiyama discloses resin fine particles that include colorants." This argument is not persuasive because while Ishiyama et al. discloses a toner that contains a colorant, Ishiyama et al. also discloses resin fine particles themselves. Applicant's attention is drawn, for example, to col. 10, lines 43-49 wherein Ishiyama et al. recites:

In the case where the coloring agent is dispersed in an aqueous system by the homogenizer using a surface active agent having a

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polarity, polar resin fine particles having an acid value of from 10 to 50 mg-KOH and a volume average particle diameter of from 100 nm or less may be added in an amount of from 0.4 to 10% by weight, preferably from 1.2 to 5.0% by weight of, to coat the coloring agent.

Therefore, Ishiyama et al. discloses resin fine particles *independent* of the colorant.

Applicant argues, "Hagi does not remedy [the] deficiency of Ishiyama." As discussed above, Examiner does not agree that Ishiyama et al. possesses the deficiency alleged.

Applicant argues, "Hagi teaches incorporating colorants into binder resin during polymerization to form toner particles" and "like Ishiyama, Hagi does not teach resin powders that do not contain colorants." These arguments are not persuasive because Examiner has relied on Hagi et al. only for the purposes of showing that it is known in the art to add inorganic fine particles to increase the fluidity of resin particles. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is further noted that claim 1 indicates that the resin powder consists essentially of resin particles, not that the resin particles consist essentially of resin. Accordingly, the resin particles may also comprise colorants and meet the claims.

Response to Declaration

The declaration under 37 CFR 1.132 filed March 16, 2005 is insufficient to overcome the rejection of the pending claims based upon Ishiyama et al. and Hagi et al. as set forth in the instant Office action because, as discussed above, Examiner does not agree with Applicant's premise that Ishiyama et al. does not disclose resin particles absent a colorant.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

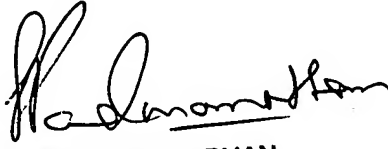
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



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